



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,836	04/17/2004	Wade C. Horton	HORTON-PA-1	8772

7590
OBER / KALER
c/o Royal W. Craig
120 East Baltimore Street
Baltimore, MD 21202

07/25/2008

EXAMINER

FIGUEROA, ADRIANA

ART UNIT	PAPER NUMBER
----------	--------------

3633

MAIL DATE	DELIVERY MODE
-----------	---------------

07/25/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/825,836	Applicant(s) HORTON, WADE C.	
	Examiner Adriana Figueroa	Art Unit 3633	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6,7,9-11,13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6,7,9-11,13 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-4, 6, 7, 9, 10, 13, 14 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kelmelis (US 6,474,846).

Regarding claim 1, Kelmelis discloses an accent frame (19, 31) for framing an article inset (17) within a cutout (14) of a planar surface (13), said inset article including a finishing ring (41) for providing a transition from said article to said planar surface; said accent frame comprising a rigid thin sheet of material (19, 31) larger in size than the finishing ring (41), said rigid thin sheet having an outer edge (o) defining an object-shape and a convex inner edge defining an aperture having a lip (23) for proper positioning with said cutout, said accent frame (21, 31) being maintained in place between and against said planar surface (13) and said finishing ring (41) by pressure of said finishing ring being retained to said article (17) via clips (15), (annotated Figure 1); whereby said accent frame (19, 31) serves as an aesthetically pleasing backdrop to said finishing ring (41) and serving to cover up any imperfections in the finish or cut of the surrounding planar surface, (annotated Figure 1).

Regarding claim 2, Kelmelis discloses a decorative outer edge (o), (annotated Figure 1).

Regarding claim 3, Kelmelis discloses said accent frame (19, 31) is seated flush with said planar surface (13), (Figure 5).

Regarding claim 4, Kelmelis discloses said frame (19, 31) flares slightly away from the planar surface (13), to provide an aesthetically pleasing depth or texture to the frame (Figure 5).

Regarding claim 6, Kelmelis does not specifically disclose said thin sheet of material is approximately 1 mm thick. However, it would have been a matter of design choice to make the thin sheet approximately 1 mm thick, since such a modification would have involved a mere change in the size of the component and would provide a light weight sheet. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955).

Regarding claim 7, Kelmelis discloses said article is a recessed lighting fixture (17), (Figure 1).

Regarding claim 9, Kelmelis discloses said planar surface (13) is a ceiling, (Figure 1).

Regarding claim 10, Kelmelis does not disclose said frame is constructed of a rigid material selected from the group consisting of wood, metal or plastic materials. However, it would have been a matter of design choice to construct the frame of wood, metal or plastic materials since it has been held to be within the general skill of a worker

Art Unit: 3633

in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Regarding claim 13, Kelmelis frame is obviously capable of being decorative and covers up any imperfections in the edges of the cutout not covered by the finishing ring.

Regarding claim 14, Kelmelis does not disclose the object-shape is a closed form selected from the group consisting of a star, flower or a house. However, it would have been an obvious matter of design choice to modify the object of Kelmelis to have a shape of a star, flower or a house, since such a modification would have involved a mere change in the shape of the component and would provide different decorative motives. A change in shape is generally recognized as being within the level of ordinary skill in the art. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

- Kelmelis discloses as discussed above, but does not disclose said frame is formed by injection molding. However, Gretz discloses a frame (10) formed by injection molding (Column 4, Lines 56-60). Therefore, it would have been obvious to a person

having ordinary skill in the arts at the time of the applicant's invention to modify the frame of Kelmelis to be formed by injection molding as taught by Gretz in order to provide a stronger and flexible frame.

Response to Arguments

3. Applicant's arguments filed 04/15/2008 have been fully considered but they are not persuasive.

In response to Applicant's argument that the Kelmelis does not teach an accent frame. Examiner asserts that the elements (19, 31) of Kelmelis are considered to be an "accent frame" since these elements are used to provide an ornamental appearance as can be seen in Figure 5. Element 19 is considered part of the accent frame.

In response to Applicant's argument regarding claim 2. Examiner asserts that the accent frame (19, 31) has an outer edge (o).

In response to Applicant's argument regarding claim 3. Examiner wants to note that the claim limitation recites "the accent frame is seated flush with the structure". The element (19) that is part of the accent frame (19, 31) is seated flush with the structure (13) as can be seen in Figure 6 with the element (91) of the structure (13) being flush with element (63) of the ring (19).

In response to Applicant's argument regarding claim 4. Examiner asserts that the accent frame (19, 31) flares away from the structure as can be seen in Figure 5 where the element (31) is considered to flare away from the structure (13) a distance equivalent to the thickness of the element.

In response to Applicant's argument regarding claim 6. Examiner wants to note that Applicant is drawing its own conclusions regarding the strength of the ceiling panel. However, Kelmelis ceiling board "may be" plaster or dry wall, which could be of a material "different" than plaster or dry wall. Hatanaka (US 6,299,727) discloses a ceiling panel that can have a thickness of 1mm (abstract).

In response to Applicant's argument regarding claim 9. Examiner wants to note that the structure (13) is considered to be part of "a ceiling".

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adriana Figueroa whose telephone number is 571-272-8281. The examiner can normally be reached on Monday-Friday 8:00 am - 4:30 pm.

Art Unit: 3633

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on 571-272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. F./
Examiner, Art Unit 3633
07/20/2008

/Brian E. Glessner/
Supervisory Patent Examiner, Art Unit 3633